

4. (Amended) A composition according to claim 1, wherein said at least one fatty alcohol is chosen from fatty alcohols of formula:



in which:

- R is chosen from linear and branched, saturated and unsaturated groups comprising from 8 to 40 carbon atoms; and
- n is a number ranging from 1 to 30.

#### REMARKS

##### *I. Status of Claims*

In the present response, claim 4 is amended, and no claims are cancelled or added. Therefore, claims 1-88 are pending in the application with claims 1, 51, 72, 75, 78, 81, and 84 being independent. Applicants acknowledge and appreciate the indication that claims 20-23, 35-38, 41, 42, 44, 48, and 53 include allowable subject matter.

##### *II. Response to § 112 Rejection*

Claim 4 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the Office, the phrase "is chosen from fatty alcohols" is redundant. Office Action at page 2. Although Applicants disagree with the rejection, in order to advance prosecution, claim 4 has been amended to delete "chosen from monoglycerolated and polyglycerolated fatty alcohols" from claim 4. Applicants submit that this amendment

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clarifies claim 4, but does not in any way narrow its scope. In this regard, claim 4 has been amended to explicitly state that which was implicit in the original claim language. Accordingly, no new matter has been added by the amendment and no estoppels are intended thereby.

In view of the above, Applicants respectfully request that this ground of rejection be withdrawn.

### **III. Response to § 103 Rejection**

The Office rejects claims 1-19, 24-34, 39, 40, 43, 45-47, 49-52, and 54-88 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,009,880 to *Grollier et al.* in view of U.S. Patent No. 6,214,326 to *Dupuis*. According to the Office, *Grollier* teaches “a cosmetic hair composition that can contain known hair dye components for dyeing hair, contains a polymer, an acrylic terpolymer, a polyglycerolated fatty alcohol . . .” Office Action at page 3. The Office concedes that *Grollier* “fails to teach the specific acrylic terpolymer as claimed as well as failing to teach a composition packaged as a kit.” *Id.*

To remedy this deficiency, the Office cites *Dupuis*. According to the Office, *Dupuis* teaches “a cosmetic hair composition that can be used to dye hair . . . and containing a thickening, acrylic terpolymer . . .” *Id.* The Office asserts that *Dupuis* also teaches “thickening polymers [that] contain a hydrophilic part and a hydrophobic part consisting of a fatty chain (see col. 1 line 26-29) . . .” *Id.* The Office further asserts that “the fatty chain of the thickening polymer is a terpolymer of maleic acid (see col. 2 line 5-9) . . .” *Id.* at 4.

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The Office concludes that it would have been obvious to modify *Grollier* by substituting its anionic terpolymer, (col. 38, lines 1-32), with the thickening, acrylic terpolymers disclosed in *Dupuis*. See Office Action at page 4. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, among other things, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. §2143. The teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Federal Circuit has emphasized the Examiner's high burden for establishing a *prima facie* case of obviousness and the requirement for specificity in the evidence necessary to support a *prima facie* case. For example, in *In re Lee*, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." 277 F.3d 1338, 1433 (Fed. Cir. 2002). Further, the court explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

*Id.* (internal citations and quotation omitted) (emphasis added). See also *In re Dembicza*k, 50 USPQ2d 1614 (Fed. Cir. 1999) (requiring a "clear and particular" suggestion to combine prior art references).

In the present case, the Office has not shown motivation to combine the references. The present invention relates to a cosmetic composition for the oxidation dyeing of keratin fibers, comprising at least one thickening polymer with at least one fatty chain and at least one fatty alcohol chosen from monoglycerolated and polyglycerolated fatty alcohols.

As noted above, the Office cites *Grollier* for its teaching of a dye composition comprising a cationic polymer, an anionic acrylic terpolymer, and a polyglycerolated fatty alcohol. Because, as admitted by the Office, *Grollier* does not teach polymers with fatty chains as claimed, the Office relies on *Dupuis* for its teaching of acrylic thickening terpolymers which allegedly have fatty chains. The Office cites col. 1, lines 26-29, of *Dupuis* for the proposition that thickening polymers contain a hydrophilic part and a hydrophobic part consisting of a fatty chain. Applicants respectfully submit that the Office has misunderstood *Dupuis*.

First, Applicants note that this section of *Dupuis* is part of its background, and does not refer to the inventive polymers (the acrylic terpolymers) of *Dupuis*. Second, this section of *Dupuis* actually teaches away from the proposed combination with *Grollier*. In particular, *Dupuis* states (col. 1, lines 21-36) (emphasis added):

For this, use is generally made of thickening and/or gelling polymers. However, the introduction of cationic polymers into thickeners often leads to problems of fluidization and of loss of clarity, and cosmetic performance levels obtained are sometimes insufficient for care products.

Thickening and/or gelling polymers are known which contain in their chain a hydrophilic part and a hydrophobic part consisting of a fatty chain, such as the product "Pemulen TR1" sold by the company Goodrich or the "Acrysol" polymers sold by the company Rohm & Haas. The polymer "Pemulen TR1", used in combination with cationic polymers,

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does not lead to a gel of satisfactory texture and does not give satisfactory cosmetic results, in particular as regards the fixing power, the softness and the feel. The polymer "Acrysol 44", used in combination with a cationic polymer, leads to a liquid and cloudy product.

In other words, *Dupuis* teaches that there are known thickening polymers having fatty chains, but that these do not work well with cationic polymers, so they are not used by *Dupuis*.

In fact, *Dupuis*' inventive terpolymers do not include a fatty chain at all. The Office asserts that the fatty chain of the thickening polymer is a terpolymer of maleic acid. Office Action at 4. Maleic acid, however, does not have an alkyl chain and, therefore, does not meet the definition of a fatty acid and cannot constitute a fatty chain. See *Hawley's Condensed Chemical Dictionary*, 14<sup>th</sup> Ed., pp. 484 and 692 (2001), submitted herewith.<sup>1</sup>

Thus, by distinguishing them in the background section and not teaching fatty polymers in the rest of the disclosure, *Dupuis* teaches away from combining a cationic polymer with any thickening polymer having a fatty chain. *Dupuis* therefore teaches away from combining its background polymers with the cationic polymer-containing composition of *Grollier*. See *Grollier*, abstract. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Here, the Office failed to consider

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<sup>1</sup> Note that *Hawley's* is submitted in response to an issue raised in the Office Action. Thus, this document is submitted as evidence directed to an issue of patentability raised in an Office action. Accordingly, payment of a fee should not be necessary for consideration of this document. See M.P.E.P. § 609 III. C(3).

*Dupuis* as a whole, and has mischaracterized it. Accordingly, *Dupuis* teaches away from the proposed combination of *Grollier* and *Dupuis*.

In addition to the above teaching away, the proposed combination fails because of the picking and choosing required to combine the teachings of *Grollier* and *Dupuis* in the proposed manner. In particular, the disclosure of *Grollier* is very broad, such that a substantial amount of picking and choosing would have been necessary to arrive at the combination relied on by the Office. For instance, *Grollier* teaches a large number of compositions other than hair dye compositions. See col. 2, lines 29-45. *Grollier* also teaches 18 classes of different anionic polymers other than the one including terpolymers being relied on by the Office. See cols. 35-45. Similarly, *Grollier* teaches many solubilizing agents other than the polyglycerolated fatty acids being relied on by the Office. See cols. 46-50. As held by the Board in *Ex parte Clapp*, a convincing line of reasoning must be presented as to why a skilled artisan would pick and choose various elements and/or concepts from the prior art to arrive at the claimed invention. 227 USPQ 972 (Bd. Pat. App. & Inter. 1985). Applicants respectfully submit that the Office has failed to provide a convincing line of reasoning as to why there would have been motivation to pick and choose, from the thousands of possibilities, the elements relied on by the Office.

Finally, although the Office implies otherwise, *Grollier* does not teach thickening polymers, let alone thickening polymers comprising at least one fatty chain. In contrast, the present invention requires at least one such thickening polymer. The Office's reliance on *Grollier*'s general teaching of thickeners (col. 54, lines 38-53) is improper because this portion of the reference does not disclose thickening "polymers," nor

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thickening polymers comprising a fatty chain. Additionally, the Office's reliance on the teaching of anionic terpolymers is also improper because *Grollier* does not teach that the anionic terpolymers are thickening polymers. Col. 38, lines 1-32.

In view of the above, Applicants respectfully request that this ground of rejection be withdrawn.

**IV. Conclusion**

Applicants respectfully request reconsideration of this application and the timely allowance of all pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 1, 2002

By:



Steven J. Helmer  
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Enclosure: *Hawley's Condensed Chemical Dictionary*,  
14<sup>th</sup> Ed., pp. 484 and 692 (2001)

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## APPENDIX

4. (Amended) A composition according to claim 1, wherein said at least one fatty alcohol [chosen from monoglycerolated and polyglycerolated fatty alcohols] is chosen from fatty alcohols of formula:



in which:

- R is chosen from linear and branched, saturated and unsaturated groups comprising from 8 to 40 carbon atoms; and
- n is a number ranging from 1 to 30.

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